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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1454.1509

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on 05/05/2008

Signature

Typed or printed name

Aaron C. Walker

Application Number

10/759,073

Filed

01/20/2004

First Named Inventor

Michael Conradt

Art Unit

2619

Examiner

Jeffrey M. Rutkowski

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 59,921

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Aaron C. Walker

Typed or printed name

(202) 434-1500

Telephone number

05/05/2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of 1 forms are submitted.

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Docket No.: 1454.1509

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Michael CONRADT et al.

Serial No. 10/759,073

Group Art Unit: 2619

Confirmation No. 7154

Filed: January 20, 2004

Examiner: Jeffrey M. Rutkowski

For: METHOD FOR CLASSIFYING NETWORK COMPONENTS OF A PACKET-ORIENTED
NETWORK

PRE-APPEAL BRIEF CONFERENCE REQUEST

Mail Stop AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

REMARKS

Claims 1-11 are pending. The independent claims are 1 and 10-11.

Independent claims 1 and 10-11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyagi et al. (U.S. Patent Application Publication No. 2002/0032761), in view of RFC 1907 (Management Information Base for Version 2 of the Simple Network Management Protocol), and further in view of RFC 1213 ((Management Information Base for Network Management of TCP/IP-based internets).

An Amendment was filed on December 10, 2007 presenting arguments that the combination of Aoyagi et al., RFC 1907, and RFC 1213 do not meet the limitations of independent claims 1 and 10-11. In the December 10, 2007 Amendment, the independent claims 1 and 10-11 were amended to incorporate features from dependent claim 5.

I. None of Aoyagi et al., RFC 1907, and RFC 1213, alone or in combination, discuss or suggest:

if the network component is a management-capable network component, determining whether the network component supports layer 3 of the OSI reference model and determining whether data packets have already been forwarded in the past between the interfaces of the management-capable network component in order to classify the management-capable network component,

as recited in independent claim 1. In other words, the invention of claim 1 provides for executing **two separate and distinct queries** for the purpose of properly classifying a management-capable network component. Claim 1 provides both a query as to whether the network component supports layer 3 of the OSI reference model (for example, via the managed object "sysServices") and a query as to whether data packets have already been forwarded in the past between the interfaces of the management-capable network component (for example, via the managed object "ipForwDatagrams"). Generally, A problem can arise in which an originally intended query (via the managed object "sysServices") to classify management capable network components cannot be trusted because incorrect information might be returned by the network components. However, the invention of claim 1 prevents this problem by **executing an additional query** (for example, via the managed object "ipForwDatagrams") that provides information that is intended for a completely different purpose, and then using the information

returned together with the returned information by the “sysServices” managed object to classify the management.

The Examiner acknowledges that Aoyagi et al. does not teach determining whether or not packets have already been forwarded and determining whether the network component supports layer 3 of the OSI reference model. The Examiner attempts to make up for this deficiency in Aoyagi et al. with reference to RFC 917 and RFC 1907. However, it is submitted the neither RFC 917 nor RFC 1907, alone or in combination, discuss or suggest:

if the network component is a management-capable network component, determining whether the network component supports layer 3 of the OSI reference model and determining whether data packets have already been forwarded in the past between the interfaces of the management-capable network component in order to classify the management-capable network component,

as recited in claim 1.

RFC 917 and RFC 1907 are “Request for Comments” technical papers that merely define the objects sysServices and ipForwDatagrams. However, neither RFC 917 nor RFC 1907 disclose the inventive steps of claim 1, which are **determining** whether the network component supports layer 3 of the OSI reference model and **determining** whether data packets **have already been forwarded** in the past between the interfaces of the management-capable network component **for the purpose of properly classifying a management-capable network component**. Therefore, neither RFC 917 nor RFC 1907, alone or in combination, teach:

if the network component is a management-capable network component, determining whether the network component supports layer 3 of the OSI reference model and determining whether data packets have already been forwarded in the past between the interfaces of the management-capable network component in order to classify the management-capable network component,

as recited in independent claim 1.

II. The Examiner’s motivation for combining the references is not proper. The Examiner indicates that it would have been obvious to use an ipForwDatagrams MIB object in the invention of Aoyagi et al. to give a strong indication the device may be categorized as a router and that it would have been obvious to use a sysServices MIB object in the invention of Aoyagi et al. to enable devices connected to a network to be classified by service type. However, as stated above, sysServices, per its own definition, would be sufficient to classify

network components, such that it would not be obvious to one skilled in the art to further include a step of determining whether data packets have already been forwarded in the past between the interfaces of the management-capable network component for the purpose of properly classifying a management-capable network component. Furthermore, The Examiner's motivation is based on hindsight knowledge, as ipForwDatagrams only provides information regarding forwarded datagrams. Therefore, the use of ipForwDatagrams for categorizing network components clearly requires knowledge of the invention of claim 1 and, therefore, is based on the hindsight knowledge of the Applicants' disclosure.

Aoyagi et al. provides no motivation for determining whether data packets have already been forwarded in the past as an indication for a classification of network components. Also, the teaching or suggestion to make the claimed combination must be found in the prior art, and not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 2142. Thus, as the Examiner has relied upon the motivations of "to give a strong indication the device may be categorized as a router" and "to enable devices connected to a network to be classified by service type," which are based on the applicants' disclosure (see paragraphs [0030]-[0033] of the specification), the Examiner has failed to establish a *prima facie* case of obviousness.

Since none of the references cited, alone or in combination, discuss or suggest all of the features of independent claim 1, and there is no proper motivation to combine these references, claim 1 patentably distinguishes over the cited prior art. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

Claims 2-4 depend either directly or indirectly from claim 1, and include all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 2-4 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 102(e) rejections is respectfully requested.

None of the cited references, alone or in combination, discuss or suggest:

a classification unit to determine whether the network component supports layer 3 of the OSI reference model and determine whether data packets have already been forwarded in the past between the interfaces of the management-capable network component in order to classify the management-capable network component, if the network component is a management-capable

network component,
as recited in independent claim 10 and there is no proper motivation to combine these references, so that claim 10 patentably distinguishes over the cited prior art. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

None of the cited references, alone or in combination, discuss or suggest:

if the network component is a management-capable network component, determining whether the network component supports layer 3 of the OSI reference model and determining whether data packets have already been forwarded in the past between the interfaces of the management-capable network component in order to classify the management-capable network component,

as recited in independent claim 11 and there is no proper motivation to combine these references, so that claim 11 patentably distinguishes over the cited prior art. Accordingly, withdrawal of the § 103(a) rejection is respectfully requested.

As discussed above, the combination of Aoyagi et al., RFC 917, and RFC 1907 does not discuss or suggest all of the features of claim 1. Fujino fails to make up for these deficiencies. Claims 6 and 9 depend either directly or indirectly from claim 1, and include all the features of claim 1, plus additional features that are not discussed or suggested by the references relied upon. Therefore, claims 6 and 9 patentably distinguish over the references relied upon for at least the reasons noted above. Accordingly, withdrawal of these § 103(a) rejections is respectfully requested.

If there are any additional fees associated with filing of this Pre-Appeal Brief Request for Review, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 5-5-08

By: 

Aaron C. Walker

Registration No. 59,921

1201 New York Avenue, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501